



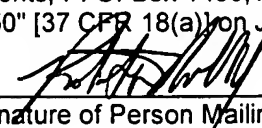
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. 10/056,832)
Applicant Curtis A. Whitcomb)
Filed January 24, 2002)
TC/A.U. 3629)
Examiner Dennis William Ruhl)

Docket No. WCA-P001-US-01)
Customer No. 27268)
Confirmation No. 3414)

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APPEAL BRIEF

In response to the Office Action mailed April 27, 2005, and further to the Notice of Appeal filed June 27, 2005, Applicant respectfully submits the following Appeal Brief.

I. Real Part in Interest:

The real party in interest is Curtis A. Whitcomb.

II. Related Appeals and Interferences:

There are no related appeals or interferences know to Applicant or Applicant's representative.

III. Status of Claims:

The currently pending claims are claims 1, 3-20, 22-39, 45 and 49-52. All of these claims are rejected. During prosecution of the present application, claims 2, 21, 40-44, and 46-48 were cancelled. The rejections of claims 1, 3-20, 22-39, 45, 49, 51,

and 52 (i.e., all of the currently pending claims except claim 50) are the subject of this Appeal.

IV. Status of Amendments:

No amendments have been filed subsequent to the final rejection.

V. Summary of Claimed Subject Matter:

Independent claim 1 is directed to a method of providing a purchaser of a product with a replica portraying the product. As explained in the specification, the product 4 (Figure 1) is typically some type of vehicle such as an automobile, an aircraft, a watercraft, a piece of farm machinery, or a recreational vehicle. (spec., pg. 3, ll. 24-26). The replica 6 (Figure 1) portraying the product generally includes a subset of the visible features of the product, and typically is a smaller, scaled version of the product. (spec., pg. 3, ll. 7-12).

The method of claim 1 includes three steps. The first step is “receiving product information relating to a visible feature of the product.” The specification provides two examples of this step. In one, a registrar 20 (Figure 1; the registrar 20 generally maintains ownership information that links products 4 and replicas 6 to owners 12 of the products 4 – spec., pg. 3, ll. 12-14) receives information relating to visual features of the product 4 such as make, model, color, wheel design, or VIN, from a merchant 14 (Figure 1; the merchant 14 generally sells products 4 to purchasers 10 – spec., pg. 3, ll. 3-4) as a result of the purchaser 10 deciding to buy a replica 6. (spec., pg. 4, ll. 3-9). In the second example, the registrar 20 obtains the product information independent of the merchant 14, such as by accessing public records or purchasing the information from a private source. (spec., pg. 4, ll. 12-16).

The second step of claim 1 is “offering to the purchaser of the product an opportunity to purchase a replica of the product, the offering step being performed by a merchant of the product.” Referring to Figure 2, the specification explains that the merchant 14 in step 220 offers the purchaser 10 an opportunity to buy a replica 6. (spec., pg. 3, ll. 28-29). Additionally, in describing the alternative embodiment of Figure

4, the specification states that “method 400 begins in step 410 with purchaser 10 purchasing a product 4 from merchant 14 for himself and/or another, and merchant 14 in step 420 offering the purchaser 10 an opportunity to buy a replica 6 that portrays the purchased product 4.” (spec., pg. 7, ll. 13-16).

The final step of claim 1 is “causing the replica including the visible feature to be transferred to the purchaser.” As the specification explains, depending upon the embodiment, the product information (and information about the owner of the product) received by the registrar 20 may be used to generate a replica order (step 240 of Figure 2), which is provided to a replica manufacturer 18. (spec., pg. 4, ll. 17-19). The replica manufacturer 18 uses the product information to provide a replica 6 that portrays the product. (spec., pg. 4, ll. 17-22). More specifically, the replica manufacturer 18 either selects an appropriate replica 6 from stock or custom manufactures the replica 6 based on the product information. (spec., pg. 5, ll. 4-8). In step 270 of Figure 2, the registrar 20 provides the owner 12 (who may be the purchaser of the product – spec., pg. 3, ll. 2-3) with the replica 6. (spec., pg. 6, ln. 10). In other alternatives, the replica manufacturer 18 or the registrar 20 transfer the replica 6 to the owner 12. (spec., pg. 6, ll. 15-17).

Independent claim 33 is a system claim that, like claim 1, is directed to providing a purchaser of a product with a replica portraying the product. Claim 33 recites “a merchant computing device; a replica manufacturer computing device; and a network connecting” the two computing devices. With reference to Figure 3, the specification explains that the network 340 may include public or private LANs and/or WANs that are coupled together via routers, switches, hubs, gateways, proxies, and/or firewalls. (spec., pg. 6, ll. 23-25). In an exemplary embodiment, the network 340 is the Internet, and the merchant computing device and replica manufacturer computing device may be any computing device that supports the appropriate Internet Protocol, such as a personal computer with web browsing software, a set-top box such as WebTV, or a palm computing device or mobile phone having web browsing capabilities. (spec., pg. 7, ln. 25 – pg. 8, ln. 11).

Claim 33 also recites that “the merchant computing device is configured to receive product information relating to a visible feature of a product purchased by the purchaser, the received product information being transferred as a replica order over the network to the replica manufacturer computing device, thereby enabling a replica including the visible feature of the product to be transferred to the purchaser.”

Regarding this language, the specification explains that the merchant 14 may enter into the merchant computing device 320 the make, model, color, wheel design, and/or VIN for the product 4 to be portrayed by the replica 6. (spec. pg. 7, ll. 22-24). In the described embodiment, the product information is transmitted as a replica order to a registrar computing device 310 (operated by a registrar 20) via network 340. (spec., pg. 7, ll. 20-21). The registrar 20 then transmits the replica order over the network 340 to the replica manufacturer computing device 330, which receives the order in step 450. (spec., pg. 8, ll. 24-25). Then, the replica manufacturer 18 either selects a replica 6 from existing stock or custom manufactures the replica 6 that portrays the visible feature(s) of the product 4. (spec., pg. 8, ln.26 – pg. 9, ln.3). Finally, in step 470 of Figure 4, one of the merchant 14, the registrar 20 or the replica manufacturer 18 provide the replica 6 to the owner 12. (spec., pg. 10, ll. 13-21).

Claim 49 is directed to a method of memorializing the purchase of a product. Like claim 1, claim 49 includes the step of “obtaining product information relating to visible features of the product.” As explained above, the specification provides two examples of this step, one where a registrar 20 receives information relating to visual features of the product 4 such as make, model, color, wheel design, or VIN, from a merchant 14 (spec., pg. 4, ll. 3-9), and another where the registrar 20 obtains the product information independent of the merchant 14, such as by accessing public records or purchasing the information from a private source. (spec., pg. 4, ll. 12-16). Claim 49 also includes the step of “obtaining information relating to the owner of the purchased product.” The specification explains that the registrar 20 may obtain ownership information, such as the owner's name and address, from the merchant 14 (step 230 of Figure 2), or from other public or private sources. (spec., pg. 4, ll. 9-15). The next step of claim 49 is “causing the creation of a replica based on the product

information, the replica portraying a visible feature of the product.” One way in which this step may be performed is by the registrar 20 ordering a replica manufacturer 18 to create a replica 6 based in the product information and the ownership information. (spec., pg. 4, ln. 17 – pg. 5, ln. 3). As explained above, the replica manufacturer 18 may then pick a replica 6 from stock or create a custom replica. (spec., pg. 5, ll. 4-8). Next, claim 49 recites the step of “causing the creation of a certificate of ownership based on the product information and the owner information, the certificate of ownership associating the owner with the replica.” As the specification explains, the certificate of ownership 8 may be generated by the replica manufacturer 18 or the registrar 20, and includes ownership information such as the name and address of the owner 12 and product information such as the make, model, color, etc. of the product 4. (spec., pg. 5, ll. 18-23). Further, the specification explains that the certificate of ownership 8 may be created such that it resembles a state-issued title and registration document. (spec., pg. 5, ll. 23-25). Finally, claim 49 recites the step of “transferring the replica and the certificate of ownership to the owner.” Referring to Figure 2, the specification explains that in step 270, the registrar 20 provides the replica and the certificate of ownership 8 to the owner 12 by sending these items to the merchant 14 for transfer to the owner 12, or by sending the items directly to the owner 12. (spec., pg. 6, ll. 10-16). Alternatively, the registrar 20 may request that the replica manufacturer 18 send the items directly to the owner 12. (spec., pg. 6, ll. 16-17).

Independent claim 51 is directed to a method for a merchant of a product to provide a replica of the product to a purchaser of the product. The first recited step is “selling the product to the purchaser.” As explained above, this step is described as being performed by the merchant 14. The second step is “offering the purchaser at the time of the sale of the product an opportunity to receive a replica of the product.” The specification explains that the merchant 14 in step 220 offers the purchaser 10 an opportunity to buy a replica 6. (spec., pg. 3, ll. 28-29). Also, in describing the alternative embodiment of Figure 4, the specification states that “method 400 begins in step 410 with purchaser 10 purchasing a product 4 from merchant 14 for himself and/or another, and merchant 14 in step 420 offering the purchaser 10 an opportunity to buy a

replica 6 that portrays the purchased product 4.” (spec., pg. 7, ll. 13-16). Finally, claim 51 recites “causing a replica of the product to be transferred to the purchaser,” which is explained in the specification as described above.

The final independent claim, claim 52, is directed to a method of memorializing the purchase of a product, and includes the steps of “obtaining product information relating to visible features of the product,” “obtaining information relating to the owner of the purchased product,” “causing the creation of a replica portraying a visible feature of the product,” “causing the creation of a certificate of ownership associating the owner with the replica,” and “transferring the replica and the certificate of ownership to the owner.” These steps are either identical or nearly identical to steps recited in claim 49 and described above. Claim 52 also recites the step of “communicating the product information and the owner information to a replica manufacturer using a computing device.” Regarding this language, the specification explains that the merchant 14 may enter into a merchant computing device 320 the make, model, color, wheel design, and/or VIN for the product 4 to be portrayed by the replica 6 (i.e., product information), and information identifying the owner 12 of the product 4. (spec. pg. 7, ll. 22-24). In the described embodiment, the product and ownership information is transmitted as a replica order to a registrar computing device 310 (operated by a registrar 20) via network 340. (spec., pg. 7, ll. 17-21). The registrar 20 then transmits the replica order over the network 340 to the replica manufacturer computing device 330, which receives the order in step 450. (spec., pg. 8, ll. 24-25).

VI. Grounds of Rejection to be Reviewed on Appeal:

Claims 1, 3-20, 22-32, 51, and 52 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claim 51 stands rejected under 35 U.S.C. §112(1) as reciting new matter.

Claims 1, 4-7, 9, 10, 12, 14, and 15 stand rejected under 35 U.S.C. §102(a) as being anticipated by The Fernwood Company, “Sweating the details . . .” article dated June 11, 2000 (hereinafter, “the Fernwood article”).

Claims 1 and 3 stand rejected under 35 U.S.C. §102(b) as being anticipated by "Hot Wheels" by Mattel (hereinafter, "the Hot Wheels ad").

Claims 33-39, and 45 stand rejected under 35 U.S.C. §102(b) as being anticipated by the Internet and two computers.

Claims 33-39, and 45 also stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,960,411 to Hartman et al. (hereinafter, "the Hartman patent").

Finally, claims 3, 8, 11, 13, 16-20, 22-32, 49, 51 and 52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Fernwood article.

VII. Argument:

A. The rejections of claims 1, 3-20, 22-32, 51, and 52 under 35 U.S.C. §101 as being directed to non-statutory subject matter

1. Claims 1, 2-7, 9-12, 14-20, 22, 24-32, and 51

In the Final Office Action of April 27, 2005 (hereinafter, "the Final Action"), the Examiner cites a two prong test for evaluating whether a claim is directed to non-statutory subject matter: 1) whether the invention is within the technological arts, and 2) whether the invention produces a useful, concrete, and tangible result. (the Final Action, pg. 2). According to the Examiner, the claims in this grouping "do not recite or require the use of any technology to perform the recited steps," "could be performed by a person verbally . . . and manually," and "are not considered to be within the technological arts." (the Final Action, pg. 2). Moreover, the Examiner contends that the disclosure of the use of computers in the specification "is not material to the determination of whether or not the claims are statutory." (the Final Action, pgs. 2-3). Applicant respectfully submits that the Examiner's interpretation and application of the law regarding 35 U.S.C. §101 is incorrect.

None of the claims of this grouping recites an abstract idea, law of nature or natural phenomena that does not apply, involve, use or advance the technological arts. The relevant issue here is not whether the recited steps could be performed manually, without application or use of technology, as the Examiner appears to assert. (the Final

Action, pg. 3). *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998) imposes no such requirement on method claims. Instead, the question is whether the claimed method is useful and produces a concrete and tangible result. *Id.* at 1358-59. Clearly, the methods of each of independent claims 1 and 51 are useful in that they provide a service that many purchasers may find valuable.¹

The claimed methods also produce concrete and tangible results as they result in the transfer of a replica of a purchased product to the purchaser. Under *State Street*, the various methods recited in independent claims 1 and 51 satisfy the requirements of 35 U.S.C. § 101.

Moreover, in *Ex parte Bowman*, 61 USPQ2d 119 (Bd. Pat. App. & Int. 2001), a case that attempted to limit the scope of the *State Street* decision, the Patent Office asked only whether the Applicant had tied the invention to any technological art or environment by reciting the use of technology in the claims or the specification. *Id.* The Board in *Bowman* confirmed the Examiner's finding that the claimed invention was an abstract idea that did not fall within the technological arts because the Applicant had not tied the disclosed and claimed invention to any technological art or environment by failing to recite the use of a computer in either the specification or the claims. See *Id.*

Unlike *Bowman*, however, the Applicant of the present case has clearly recited the use of computing devices, networks and other technology throughout the specification in regards to the subject matter these claims. The entire discussion of the system and method of Figures 3 and 4 (beginning at page 6, line 18 and ending at page 10, line 21 of the specification) relates to technological implementations of the steps recited in the rejected claims.

Therefore, because Applicant's specification discloses the use of computer technology to carry out steps of each of the rejected claims, Applicant submits that the claimed subject matter is tied to the technological arts and meets the technological arts requirement of 35 U.S.C. § 101. As such, Applicant requests reversal of the Examiner's rejections of these claims.

¹ Applicant notes that the Examiner did not list independent claim 49 as being directed to non-statutory subject matter. Perhaps this was an oversight as claim 49 does not claim subject matter that is substantially different than that recited in other claims in this grouping.

2. Claims 8 and 13

Claim 8 recites the step of “providing a registrar computing device and a merchant computing device connected to the registrar computing device by a network, the registrar receiving the product information from the merchant computing device, over the network, and through the registrar computing device.” Similarly, claim 13 recites the step of “providing a registrar computing device and a replica manufacturer computing device connected to the registrar computing device by a network, the replica order being transferred from the registrar computing device, over the network to the replica manufacturer computing device.” Thus, each claim recites two computing devices connected by a network, as well as the transfer of information from one computing device to the other over the network. Yet, the Examiner has rejected these claims as not being directed to statutory subject matter.

More specifically, the Examiner has concluded that the “step of just receiving information via a network by using computing devices is nothing more than a trivial use of technology [as] nothing is being manipulated in any manner or being changed from one state to another . . .” (the Final Action, pg. 3). Without citation to any law, precedent or rule, the Examiner concluded that “[t]his is not considered to be a *meaningful use of technology* that would render the claims statutory . . .” (the Final Action, pg. 3) (emphasis added). Applicant respectfully submits that an Examiner’s subjective determination of the meaningfulness of claimed technology cannot possibly be the correct standard for assessing compliance with 35 U.S.C. §101. Indeed, such an arbitrary standard is reminiscent of the “flash of genius” requirement for patentability, abolished by Congress with The Patent Act of 1952.

In a telephonic interview conducted subsequent to the Final Action, the Examiner admitted that he could not cite authority to support his conclusion regarding these claims. The Examiner explained that he was simply following the instructions of his supervisor, who had informed him that the Patent Office’s “position” regarding 35 U.S.C. §101 was that displaying or receiving information using a computer was a “trivial use” of technology that would not render the claimed subject matter statutory. The Examiner’s supervisor declined to discuss the issue with Applicant’s representative.

The Supreme Court has given §101 a broad interpretation, concluding that Congress intended it to “include anything under the sun that is made by man.” See *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). Of course, the Court has also identified three categories of unpatentable subject matter: “laws of nature, natural phenomena, and abstract ideas.” See *Diamond v. Diehr*, 450 U.S. 175, 185 (1981). Despite an exhaustive search of post-*State Street* decisions, Applicant has found nothing in the law that would suggest in any way whatsoever that a fourth exception has evolved (i.e., a non-meaningful use of technology). Clearly, a claim that expressly recites two computing devices connected by a network for exchanging information cannot reasonably be considered a law of nature, a natural phenomena, or an abstract idea. Accordingly, Applicant respectfully requests reversal of the Examiner’s rejections of these claims.

3. Claim 23

Claim 23 recites “wherein the registrar includes a registrar computing device having a database, the database containing the updated registration records.” Here again, the Examiner concluded that “entering data into a database of a computing device is not considered to be a meaningful use of technology . . .” (the Final Action, pg. 3). Applicant respectfully submits that even if claim 23 claimed simply entering data into a database it would be statutory for the reasons outlined above. Contrary to the Examiner’s assertions, however, claim 23 expressly claims, among other things, “a computing device having a database.” As the standard for patentability is not the extent to which the Examiner thinks the technology is “meaningful,” Applicant respectfully submits that a claim that recites a computing device with a database cannot properly be rejected as non-statutory. Accordingly, Applicant requests reversal of the Examiner’s rejection of claim 23.

4. Claim 52

Like the previous claims discussed in this section, claim 52 recites, among other things, the step of “communicating the product information and the owner information to

a replica manufacturer using a computing device.” The Examiner did not specifically address claim 52 in the Final Action. Instead, he included claim 52 in a list of claims that he claimed “do not recite or require the use of any technology to perform the recited steps.” Clearly, claim 52 recites technology to perform the step of communicating. To the extent the Examiner changes his position to a rejection based on the “meaningfulness” of the claimed technology, Applicant disagrees for the reasons discussed above in sections VII(A)(2)-(3).

B. The rejection of claim 51 under 35 U.S.C. §112(1) as reciting new matter

Claim 51 recites the step of “offering the purchaser at the time of the sale of the product an opportunity to receive a replica of the product.” According to the Examiner, this step constitutes “subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” (the Final Action, pg. 4). More specifically, the Examiner asserts that the original specification “fails to provide support for the limitation . . . ‘offering the purchaser at the time of the sale of the product,’” because the specification did not specify the timing of the offer. (the Final Action, pg. 4) (emphasis in original). As such, according to the Examiner, claim 51 recites new matter. Again, Applicant respectfully disagrees.

The specification describes the offering limitation at least twice. First, with reference to Figure 2, the specification explains:

[A] method of memorializing the purchase of a product by providing the purchaser 10 of the product 4 with a replica 6 begins in step 210 with the purchaser 10 purchasing a product 4 from merchant 14 for himself and/or another. Typically, the product 4 is some type of vehicle

* * *

Merchant 14 in step 220 offers purchaser 10 an opportunity to buy a replica 6 that portrays the purchased product 4. Merchant 14 may provide purchasers 10 or owners 12 with a replica 6 in the ordinary course of business (omitting step 220).

(spec., pg. 3, ll. 22-30).

While the above-quoted passage does not expressly state that the merchant 14 offers the purchaser 10 an opportunity to buy a replica *at the time of the sale*, clearly one of ordinary skill in the art would understand that the offer could be made at the time of the sale, or at some later time. As such, the offering limitation of claim 51 cannot reasonably be considered new matter.

Later, with reference to the method depicted in Figure 4, the specification explains:

Like the method of Fig. 2, method 400 begins in step 410 with purchaser 10 purchasing a product 4 from the merchant 14 for himself and/or another, and merchant 14 in step 420 offering purchaser 10 an opportunity to buy a replica 6 that portrays the purchased product 4. (spec., pg. 7, ll. 13-16).

Thus, in a single sentence the specification states that the method begins with the purchaser purchasing the product and the merchant offering an opportunity to buy a replica. In short, this sentence discloses, in present tense, a single transaction including purchasing the product and offering the replica. It is inconceivable to Applicant that such disclosure would not be understood by a skilled artisan as teaching the limitation of offering the opportunity to buy a replica "at the time of the sale."

The Examiner's only response to Applicant's argument is that the specification "can allow for the offer to be made at a later time (after the purchase has been made) and because of this the making of the offer 'at the same time' as the sale of the product is new matter that is not inherent to the originally disclosed invention." (the Final Action, pg. 4). In other words, the Examiner concludes that disclosure of an offer made at or after the sale precludes a claim directed to one of the two disclosed alternatives. This is clearly an improper analysis.

As a preliminary matter, the above-quoted passages constitute express disclosure of the offer being made at the time of the sale of the product. Even if that were not the case, the above-quoted passages clearly convey that one time at which the offer can be made is at the time of the sale. Having disclosed at least that the offer could be made at the time of the sale, Applicant is clearly entitled to claim the step of offering the replica at the time of the sale. As such, Applicant respectfully requests reversal of the Examiner's rejection.

C. The rejections of claims 1, 4-7, 9, 10, 12, 14, and 15 under 35 U.S.C. §102(a) as being anticipated by the Fernwood article

The Fernwood article is an article from the Portland Press Herald, published June 11, 2000, about a husband and wife (hereinafter, "Fernwood") in Maine that makes custom miniatures of buildings and scenes. In describing the early days of the business, the Fernwood article states: "Sandy Manship was a nurse and self-taught painter. Looking for some extra cash for family activities, she started working with a Bangor bank to hand paint replicas of newly purchased homes, which were then given to the buyers." (the Fernwood article, pg. 2). This constitutes the entire portion of the disclosure relied upon by the Examiner as anticipating all of the claims in this section.

1. Claims 1 and 4

Regarding claims 1 and 4, the Examiner states that the Fernwood article discloses a "purchaser" (the home buyer), a "product" (the home), and a "merchant" (the bank). According to the Examiner, it is inherent in the Fernwood article that the bank and Fernwood receive information relating to a visible feature of the home, and plainly disclosed that the home replica is given to the home buyer. What the Examiner ignores entirely, however, is that claim 1 requires the step of "offering to the purchaser of the product an opportunity to purchase a replica of the product, the offering step being performed by a merchant of the product." Nothing in the Fernwood article teaches, expressly or inherently, that the bank offered the home buyer an opportunity to purchase a replica of the home. If anything, the Fernwood article seems to indicate that the bank simply asked Fernwood to paint replicas on its own accord, and provided those replicas as surprise gifts to the home owners. Accordingly, Applicant respectfully requests reversal of the Examiner's rejections of these claims.

2. Claims 5, 9, and 10

Claims 5, 9, and 10 depend (either directly or indirectly) from claim 1, and are believed to be allowable for at least the reasons set forth above with regard to claim 1.

3. Claim 6

Claim 6 adds to claim 5 the limitation that the registrar "also obtains information relating to an owner of the product to associate the product and the replica with the

owner.” For this, the Examiner states that “the information of what the replica is to look like (style of home) is considered by the examiner to be information related to an owner of the product because the owner has purchased that style of house.” (the Final Action, pg. 6). The Examiner’s position is flawed for at least two reasons. First, the Examiner has concluded that product information and owner information are the same thing. The Examiner asserts that product information regarding a visible feature of the home (i.e., the style of the home), also constitutes information relating to the owner of the home. Applicant has claimed two types of information, one relating to a visible feature of the product and the other relating to the owner of the product. The Examiner cannot properly cite a visible feature of the product as satisfying disclosure of both types of information. Second, even if the Fernwood article disclosed a registrar (which it does not) that obtains information relating to an owner (which it does not), it certainly does not disclose, suggest or hint that the registrar obtains the owner information “to associate the product and the replica with the owner.” Regarding this express limitation of claim 6, the Examiner is silent. Thus, Applicant respectfully requests reversal of the Examiner’s rejection of claim 6.

4. Claim 7

Claim 7 includes the step of “providing a registrar for receiving the product information from the merchant, the registrar using the product information and information relating to an owner of the product to associate the product and the replica with the owner.” This step is similar to the step of claim 6 described above. For claim 7, the Examiner states that “the claimed registrar is an employee of Fernwood, such as the sales representative who is responsible for the sales of the replicas. The sales representative’s job is the [sic: to] sell the replicas so this is the person who would be taking the order information from the merchant (the Bank).” (the Final Action, pg. 6). The Examiner addresses the limitation of claim 7 that the registrar “associate” the product and the replica with the owner by stating that the “limitation is so broad that it includes a person making a mental association that a given replica is for the person who owns a home that looks like the replica; this is an association as claimed.” (the Final Action, pg. 6). Applicant need not rebut the Examiner’s position regarding the meaning

of an association, however, because nothing resembling the Examiner's description of an association *is disclosed* anywhere in the Fernwood article. Accordingly, Applicant respectfully requests reversal of the Examiner's rejection of claim 7.

5. Claim 12

Claim 12 recites the step of "transferring a replica order from the registrar to a replica manufacturer." The Examiner's position is that one of the employee's of Fernwood is a "replica manufacturer," a sales representative of Fernwood is a "registrar," and "[w]hen the sales representative makes a sale, one of the manufacturers must be given a replica order so they know what to make." (the Final Action, pg. 7). The problem with this analysis is that no information is described, in order form or otherwise, as being transferred between the "employees" of Fernwood. As such, the Examiner's rejection should be reversed.

7. Claims 14 and 15

The Examiner argues that claims 14 and 15 are anticipated by the Fernwood article. As claims 14 and 15 depend from independent claim 13, which is not rejected as being anticipated by any reference, the rejections of claims 14 and 15 under 35 U.S.C. §102 are improper.

D. The rejections of claims 1 and 3 under 35 U.S.C. §102(b) as being anticipated by the Hot Wheels reference

As indicated above, claim 1 requires, among other things, the step of "offering to the purchaser of the product an opportunity to purchase a replica of the product, the offering step being performed by a merchant of the product." The Mattel ad is simply a web page print out that indicates that Mattel sells miniature cars. The Examiner argues that the "claimed 'merchant' is whoever is selling the cars, such as a toy store that sells Hot Wheels. The fact that the cars are being sold by the merchant is in and of itself an offer to customers to purchase the replica." (the Final Action, pg. 8). The Examiner has confused the product with the replica of the product. Assuming that an automobile is the product, the merchant of claim 1 is the merchant of the automobile. Toy stores do not sell automobiles, they sell Hot Wheels. Accordingly, the fact that Hot Wheels cars exist, does not anticipate a claim that, in this example, requires a merchant of

automobiles to offer a purchaser of an automobile an opportunity to purchase a replica of the automobile. As such, Applicant respectfully requests reversal of the Examiner's rejection of these claims.

E. The rejections of claims 33-39, and 45 under 35 U.S.C. §102(b) as being anticipated by the Internet and two computers

1. Claims 33-36 and 39

Claims 34-36 and 39 depend either directly or indirectly from independent claim 33, which reads as follows:

33. A system for providing a purchaser of a product with a replica portraying the product, including:
a merchant computing device;
a replica manufacturer computing device; and
a network connecting the merchant computing device and the replica manufacturer computing device;
wherein the merchant computing device is configured to receive product information relating to a visible feature of a product purchased by the purchaser, the received product information being transferred as a replica order over the network to the replica manufacturer computing device, thereby enabling a replica including the visible feature of the product to be transferred to the purchaser.

The Examiner's position is that the existence of the Internet, which includes multiple computers connected via networks, anticipates claim 33. Essentially, the Examiner has ignored entirely the content of the wherein clause of claim 33, which requires, among other things, that "information [relating to a visible feature of a product be] transferred as a replica order over the network to the replica manufacturer computing device, thereby enabling a replica . . . to be transferred to the purchaser" of the product. According to the Examiner, "[r]eciting that the information is transferred as an order over the network thereby enabling a replica to be made is a recitation directed to the intended use of the system (a method step) and defines nothing further structurally to the claimed system." (the Final Action, pg. 9). Applicant respectfully disagrees.

The language of the wherein clause cited above is not a statement of intended use, it is a functional limitation of the claim. It is clearly proper to claim subject matter in

terms of its function. It is also true, however, that where the structure of the claim is disclosed in the prior art but the function is not, a rejection under 35 U.S.C. §102 or §103 may still be proper so long as the function is inherent in the prior art. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (The Board reversed the examiner's rejection because the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency). Here, the Examiner has made no argument and presented no evidence that the functional limitation of transferring information relating to a visible feature of a product as a replica order to a replica manufacturer computing device to enable a replica to be transferred to the product purchaser necessarily flows from the existence of the Internet. Accordingly, Applicant respectfully requests reversal of the Examiner's rejections of these claims.

2. Claim 37

Claim 37 adds the limitation of "a replica computing device" that is connected to the other computing devices over the network. Claim 37 also requires that "the product information [is] transferred from the merchant computing device to the registrar computing device which generates the replica order." Again, the Examiner dismisses this limitation, arguing that it is "another recitation of the intended use of the system and defines no further structure to the system." (the Final Action, pg. 9). Applicant respectfully submits that these functional limitations, that the registrar computing device receive product information from the merchant computing device and generate the replica order, are not statements of intended use. Thus, the Examiner must somehow demonstrate that a computing device having these functional characteristics is inherently disclosed in the prior art. Merely referring to the Internet does not satisfy the Examiner's burden. As such, Applicant respectfully submits that the Examiners rejection should be reversed.

3. Claim 38

Claim 38 depends from claim 37, and adds the limitation that “the registrar computing device includes a database containing information corresponding to a plurality of replica manufacturers.” The Examiner states that “[t]he kind of data stored is non-functional descriptive material that does not serve as a limitation. Reciting the kind of data that is stored on a computer is not a feature that will be considered as a patentably distinguishing feature.” (the Final Action, pg. 9). Applicant again believes the Examiner is wrong. A database is clearly a structural limitation. The data in the database is also structural. Data is not an act or a step, it is a thing. It either exists physically, or not, as anyone who has lost data can certainly attest. Thus, as the Examiner has not identified a prior art computing device that includes a database of information corresponding to a plurality of replica manufacturers or demonstrated that such a limitation is inherent, the Examiner’s rejection should be reversed.

4. Claim 45

Claim 45 also depends from claim 37, and adds the limitation that “the registrar computing device updates registration information in a database associating the product and the replica with an owner of the product.” The Examiner again asserts that this limitation is an intended use, and that “[a]ny computer is capable of updating records stored in a database.” (the Final Action, pg. 10). Contrary to the Examiner’s assertion, claim 45 adds a specific functional limitation to the registrar computing device – that it function to update information in a database associating a product and a replica with a product owner. The Examiner must identify a computer that performs this function, or demonstrate that it is inherent in the art. As the Examiner has not met this burden, the rejection of claim 45 should be reversed.

F. The rejections of claims 33-39, and 45 under 35 U.S.C. §102(b) as being anticipated by the Hartman patent

1. Claims 33-36, and 39

For the rejections of the claims of this grouping, the Examiner merely identified a famous Internet patent instead of stating that the Internet exists (see the previous

section of this brief). The Examiner has again, however, ignored the wherein clause of claim 33, the claim from which all of the other claims in this grouping depend, which requires that "information [relating to a visible feature of a product be] transferred as a replica order over the network to the replica manufacturer computing device, thereby enabling a replica . . . to be transferred to the purchaser" of the product. According to the Examiner, "[t]he type of information is considered to be non-functional descriptive material that does not serve as a limitation." Applicant respectfully disagrees. As indicated above, the language of the wherein clause includes a functional limitation of the claim, and the Examiner has made no argument and presented no evidence that the functional limitation of transferring information relating to a visible feature of a product as a replica order to a replica manufacturer computing device to enable a replica to be transferred to the product purchaser is disclosed in or necessarily flows from the Hartman patent. Accordingly, Applicant respectfully requests reversal of the Examiner's rejections of these claims.

2. Claims 37, 38, and 45

As the Examiner has asserted the same basis for rejection of these claims in view of the Hartman patent as he did in view of the Internet, none of which are based on the disclosure of the Hartman patent, the arguments relating to claims 37, 38, and 45 presented above in Sections VII(E)(2)-(4) applied equally here.

G. The rejections of claims 3, 8, 11, 13, 16-20, 22-32, 49, 51 and 52 under 35 U.S.C. §103(a) as being unpatentable over the Fernwood article

1. Claims 3, 8, 19, 23, 24, 27, 28, 31, and 32

Claims 3, 8, 19, 23, 24, 27, 28, 31, and 32 depend (either directly or indirectly) from claim 1, and are believed to be allowable for at least the reasons set forth above with regard to claim 1.

2. Claim 52

Claim 52 reads as follows:

52. A method of memorializing the purchase of a product, including the steps of:

obtaining product information relating to visible features of the product;
obtaining information relating to the owner of the purchased product;
communicating the product information and the owner information to a replica manufacturer using a computing device;
causing the creation of a replica portraying a visible feature of the product;
causing the creation of a certificate of ownership associating the owner with the replica; and
transferring the replica and the certificate of ownership to the owner.

In rejecting this claim, the Examiner points to a passage in the Fernwood article stating that “Fernwood of Maine expects to have a Web site.” (the Fernwood article, pg. 4). From this passage, the Examiner asserts that it would have been obvious that the Bank (using a “merchant computing device”) would submit orders for home replicas over the Internet to a Fernwood employee (using a “registrar computing device”). The Applicant respectfully disagrees with the Examiner’s conclusions regarding what the Fernwood passage suggests. Applicant need not contest those conclusions, however, because the Examiner has failed to demonstrate a suggestion in the Fernwood article or elsewhere for the last two steps of the claim. Nothing in the Fernwood article (or any of the other cited art) teaches, suggests, or even hints at the creation or transfer of a certificate of ownership as claimed. The Examiner contends that a receipt of sale of a replica would be obvious in view of the Fernwood article. (the Final Action, pg. 14). A receipt, however, is not a certificate of ownership that associates the owner with the replica. Accordingly, Applicant respectfully requests that the Examiner’s rejection be reversed.

3. Claim 13

Claim 13 reads as follows:

“13. The method of claim 12 further including the step of providing a registrar computing device and a replica manufacturer computing device connected to the registrar computing device by a network, the replica order being transferred from the registrar computing device, over the network to the replica manufacturer computing device.”

Merely based on the fact that the Fernwood article indicates that Fernwood expects to have a web site, the Examiner constructs a Fernwood that has employees with multiple computers connected together over a network. (the Final Action, pg. 13). Of course, none of this is disclosed in the Fernwood article. Even assuming, however, that the mention of a web site could support the conclusion that more than one computer is used at Fernwood, Applicant respectfully submits that nothing in the Fernwood article suggests that replica orders will be transferred over a network from one Fernwood computing device to another Fernwood computing device as the Examiner suggests. Indeed, the Fernwood article appears to teach away from the subject matter of claim 13 in that a small company would not ordinarily distribute information internally using the Internet.

4. Claim 11

Claim 11 recites the step of "causing the registrar to associate the owner information with a product identification number and a replica identification number." For this, the Examiner summarily concludes that "[i]t would have been obvious . . . to use an invoice number or an order number (some number that represents the transaction) for purposes of accounting and record keeping. The claim reads on any number used to identify a particular product/transaction because both numbers can be the same." (the Final Action, pg. 13). With no disclosure in the Fernwood article of "owner information," a "product identification number," or a "replica identification number," it is clearly an impermissible use of hindsight to conclude that it would have been obvious to associate the owner information with the other two numbers. Perhaps an invoice number is used by Fernwood, but there is absolutely no suggestion in the Fernwood article that a number identifying the home (product) and a number identifying the replica are used. Further, there is clearly no suggestion that such numbers are associated with the owner of the home. Accordingly, Applicant respectfully requests that the Examiner's rejection be reversed.

5. Claims 16, 29, and 49

Each of these claims recites “a certificate of ownership” that associates the replica (or both the replica and the product) with owner of the product. The Examiner asserts that a receipt is obvious from the Fernwood article “so that the owner can have proof of ownership and proof of the transaction occurring.” (the Final Action, pg. 14). First, no receipt is suggested in the Fernwood article. Second, a receipt generally indicates what was sold and the price of the item. A receipt does not associate the owner of the purchased item with the item itself. Clearly, nothing in the Fernwood article suggests that any type of document is created that associates home owners with their replicas. Accordingly, Applicant respectfully requests reversal of the rejections of these claims.

6. Claims 17 and 18

Each of these claims depends from claim 16 (discussed above), and are believed patentable for at least the reasons set forth in the preceding section. According to the Examiner, “[s]omebody has to make the receipt, who actually makes it is irrelevant and does not amount to anything patentable.” (the Final Action, pg. 14). As explained above, a receipt is not a certificate of ownership. Claim 17 recites that the replica manufacturer makes the certificate of ownership and provides it to the registrar. Applicant respectfully submits that the Examiner cannot simply declare that a step in a method claim requiring that one entity create an item and provide it to another entity “does not amount to anything patentable.” (the Final Action, pg. 14). The Examiner must point to some teaching or suggestion in the prior art of the claimed step. As the Examiner has failed to do so, Applicant requests that the rejections of these claims be reversed.

7. Claim 20

Claim 20 recites the limitation that “the certificate of ownership includes the product information and the owner information.” The Examiner states that what the receipt includes as far as information goes is considered to be printed matter that is not related in any way to the method and is non-functional descriptive material. Product information and owner information

are very broad terms and are just interpreted as 'information' or data on the receipt. A receipt will inherently contain some information that may be date, cost, item number, item description, etc. and this satisfies what is claimed.

(the Final Action, pg. 15). As recited in claim 16, from which claim 20 depends, a step in the claimed method is to create the certificate of ownership associating the product and the replica with the owner. Clearly, further reciting the contents of the certificate of ownership is related to the claimed method. Moreover, as the recited content of the certificate of ownership plainly constitutes a structural limitation of the claim, the Examiner is incorrect in dismissing it as "non-functional descriptive material," a label that is unfamiliar to the Applicant. Additionally, as explained above, the receipt the Examiner refers to (undisclosed in the Fernwood article) is not a document that associates the product and the replica with the owner. Finally, although product information may be a broad term, it means more than just "information." As recited in claim 1, product information relates to a visible feature of the product. It is pure hindsight to conclude that the Fernwood article suggests the certificate of ownership with its claimed contents. As such, the Examiner's rejection should be reversed.

8. Claim 22

Claim 22 recites the step of "causing the registrar to update registration records based on the replica and the certificate of ownership." For this, the Examiner takes the following position:

The examiner interprets this to be an act of Fernwood keeping track of their business as far as what work is currently on order, outstanding orders as well as tracking finished replicas and their shipments. It would have been obvious . . . to update company records of Fernwood to track the fact that a given replica is done being made and has been shipped out. This claim reads on the act of a company just keeping track of current orders and information on the orders that is relevant to a manufacturing business that makes products and ships products. (the Final Action, pg. 15). Nothing in the Fernwood article suggests modifying it to teach any of the specifics the Examiner has imagined in the above-quoted passage. At a minimum, the Examiner has failed to adequately point out how such a modification of

the Fernwood article is suggested. Thus, Applicant submits that the rejection of claim 22 should be reversed.

9. Claim 25

Claim 25 requires the step of “obtaining the replica from stock.” The Examiner asserts that he “considers this to be the taking of a finished replica from an area where finished replicas are kept (a table, a shelf, etc.).” (the Final Action, pg. 15). Again, the Examiner has failed to identify what in the Fernwood article would suggest his interpretation of this step. The Examiner cannot simply use the claimed subject matter to declare that it would have been obvious. Moreover, the Fernwood article suggests that replicas are made only after they are ordered. (the Fernwood article, pg. 3; “Fernwood of Maine will custom make any landmark. A client must buy at least 60 copies.”). This suggests that Fernwood does not keep an inventory of replicas such that one could be obtained from stock as claimed in claim 25. Accordingly, the Examiner’s rejection should be reversed.

10. Claim 30

Claim 30 specifies that the step of transferring the replica to the owner “includes the steps of transferring the replica from the registrar to a merchant of the product, and from the merchant to the owner.” The Examiner considers the merchant of the product to be “the postal service that completed replicas are to be mailed by.” (the Final Action, pg. 16). Of course, nothing in the Fernwood article suggests the postal service. More importantly, however, the Examiner has provided no reasoning for his conclusion that the postal service could properly be considered “a merchant of the product.” In the context of this claim as interpreted by the Examiner, the “product” is a home. Clearly, the postal service does not sell homes. For at least these reasons, the Examiner’s rejection should be reversed.


11. Claim 51

Among other things, claim 51 recites the step of “offering the purchaser at the time of the sale of the product an opportunity to receive a replica of the product.” The Examiner admits that this step is not taught in the Fernwood article, but states that he “feels that it is common sense and would be obvious . . . to ask the new home owner at

closing if they would like to receive a free gift of a replica of their newly purchased home . . .” (the Final Action, pg. 17). Clearly, this conclusion is a result of impermissible hindsight. The Examiner has taken Applicant’s recitation of the timing of the offer and, without anything more, concluded that such an offer would have been obvious. Moreover, the Fernwood article states that Fernwood “started working with a Bangor bank to hand paint replicas of newly purchased homes, which were then given to the buyers.” (the Fernwood article, pg. 2). If anything, this passage suggests that Fernwood persuaded the bank to purchase replicas after the homes were sold, and that the bank made no offer to the buyers at all, but later gave the replicas as gifts.

The Examiner also concluded that “the timing of the offer for the replica [is] one of sales style because the timing . . . has no material affect on the end result of the invention. . . . The timing of the offer does not materially affect the claimed invention and is considered to be obvious for this reason.” (the Final Action, pg. 17). Applicant respectfully submits that the Examiner’s opinion that the timing of the offer is “sales style,” and that it does not materially affect the claimed invention has no place in a proper analysis of obviousness. The question is not whether a claimed step “materially affects the claimed invention,” a standard of unknown origin. The question is whether the claimed step is taught or suggested in the prior art. As explained above, this step is not. Accordingly, Applicant respectfully requests that the Examiner’s rejection of claim 51 be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert D. Null', is written over a horizontal line.

Robert D. Null, Reg. No. 40,746
Attorney for Applicant

CLAIMS APPENDIX

Claim 1. A method of providing a purchaser of a product with a replica portraying the product including the steps of:

receiving product information relating to a visible feature of the product;
offering to the purchaser of the product an opportunity to purchase a replica of the product, the offering step being performed by a merchant of the product; and
causing the replica including the visible feature to be transferred to the purchaser.

Claim 3. The method of claim 1 wherein the product is a vehicle, the product information including one of make, model, color, wheel design, and VIN.

Claim 4. The method of claim 1 wherein the merchant of the product receives the product information.

Claim 5. The method of claim 1 wherein a registrar receives the product information.

Claim 6. The method of claim 5 wherein the registrar also obtains information relating to an owner of the product to associate the product and the replica with the owner.

Claim 7. The method of claim 4 further including the step of providing a registrar for receiving the product information from the merchant, the registrar using the product information and information relating to an owner of the product to associate the product and the replica with the owner.

Claim 8. The method of claim 7 further including the step of providing a registrar computing device and a merchant computing device connected to the registrar computing device by a network, the registrar receiving the product information from the merchant computing device, over the network, and through the registrar computing device.

Claim 9. The method of claim 7 wherein the purchaser is the owner of the product.

Claim 10. The method of claim 7 wherein the owner information includes one of owner name and address.

Claim 11. The method of claim 7 further including the step of causing the registrar to associate the owner information with a product identification number and a replica identification number.

Claim 12. The method of claim 7 further including the step of transferring a replica order from the registrar to a replica manufacturer.

Claim 13. The method of claim 12 further including the step of providing a registrar computing device and a replica manufacturer computing device connected to the registrar computing device by a network, the replica order being transferred from the registrar computing device, over the network to the replica manufacturer computing device.

Claim 14. The method of claim 12 wherein the replica order includes the product information and the owner information.

Claim 15. The method of claim 12 wherein the replica order includes an identifier from which the replica manufacturer can determine the product information.

Claim 16. The method of claim 12 further including the step of creating a certificate of ownership associating the product and the replica with the owner.

Claim 17. The method of claim 16 wherein the replica manufacturer creates the certificate of ownership and provides the certificate of ownership to the registrar.

Claim 18. The method of claim 16 wherein the registrar creates the certificate of ownership.

Claim 19. The method of claim 16 further including the step of transferring the replica and the certificate of ownership from the replica manufacturer to the registrar.

Claim 20. The method of claim 16 wherein the certificate of ownership includes the product information and the owner information.

Claim 22. The method of claim 16 further including the step of causing the registrar to update registration records based on the replica and the certificate of ownership.

Claim 23. The method of claim 22 wherein the registrar includes a registrar computing device having a database, the database containing the updated registration records.

Claim 24. The method of claim 12 further including the step of transferring the replica from the replica manufacturer to the registrar.

Claim 25. The method of claim 24 further including the step of obtaining the replica from stock.

Claim 26. The method of claim 24 further including the step of custom building the replica.

Claim 27. The method of claim 24 wherein the replica includes an identification number.

Claim 28. The method of claim 27 wherein the replica identification number has characteristics in common with characteristics of an identification number associated with the product.

Claim 29. The method of claim 16 further including the step of transferring to the owner the replica and the certificate of ownership associating the product and the replica with the owner.

Claim 30. The method of claim 29 wherein the step of transferring the replica to the owner includes the steps of transferring the replica from the registrar to a merchant of the product, and from the merchant to the owner.

Claim 31. The method of claim 29 wherein the step of transferring the replica to the owner includes the step of transferring the replica from the registrar directly to the owner.

Claim 32. The method of claim 29 wherein the step of transferring the replica to the owner includes the step of transferring the replica from the replica manufacturer directly to the owner.

Claim 33. A system for providing a purchaser of a product with a replica portraying the product, including:

- a merchant computing device;
- a replica manufacturer computing device; and
- a network connecting the merchant computing device and the replica manufacturer computing device;

wherein the merchant computing device is configured to receive product information relating to a visible feature of a product purchased by the purchaser, the received product information being transferred as a replica order over the network to the replica manufacturer computing device, thereby enabling a replica including the visible feature of the product to be transferred to the purchaser.

Claim 34. The system of claim 33 wherein the network is the Internet.

Claim 35. The system of claim 33 wherein the merchant computing device and the replica manufacturer computing device are personal computers executing web-browser applications.

Claim 36. The system of claim 33 wherein the replica order includes the product information and information relating to an owner of the product.

Claim 37. The system of claim 33 further including a registrar computing device connected to the merchant computing device and the replica manufacturer computing device via the network, the product information being transferred from the merchant computing device to the registrar computing device which generates the replica order.

Claim 38. The system of claim 37 wherein the registrar computing device includes a database containing information corresponding to a plurality of replica manufacturers.

Claim 39. The system of claim 37 wherein the replica order includes the product information and information relating to an owner of the product.

Claim 45. The system of claim 37 wherein the registrar computing device updates registration information in a database associating the product and the replica with an owner of the product.

Claim 49. A method of memorializing the purchase of a product, including the steps of:

- obtaining product information relating to visible features of the product;
- obtaining information relating to the owner of the purchased product;
- causing the creation of a replica based on the product information, the replica portraying a visible feature of the product;

causing the creation of a certificate of ownership based on the product information and the owner information, the certificate of ownership associating the owner with the replica; and

transferring the replica and the certificate of ownership to the owner.

Claim 51. A method for a merchant of a product to provide a replica of the product to a purchaser of the product including the steps of:

selling the product to the purchaser;

offering the purchaser at the time of the sale of the product an opportunity to receive a replica of the product; and

causing a replica of the product to be transferred to the purchaser.

Claim 52. A method of memorializing the purchase of a product, including the steps of:

obtaining product information relating to visible features of the product;

obtaining information relating to the owner of the purchased product;

communicating the product information and the owner information to a replica manufacturer using a computing device;

causing the creation of a replica portraying a visible feature of the product;

causing the creation of a certificate of ownership associating the owner with the replica; and

transferring the replica and the certificate of ownership to the owner.

EVIDENCE APPENDIX

No evidence has been submitted pursuant to §§1.130, 1.131, or 1.132. Copies of the references relied upon by the Examiner are included herein.

RELATED PROCEEDINGS APPENDIX

No related proceedings exist.

Sweating the details Fernwood fo Maine's colorful, handcrafted replicas of buildings and scenes find a ready, robust market.

Portland Press Herald; Portland, Me.; Jun 11, 2000; TUX TURKEL Staff Writer;

Sic:321999

Sub Title: [CITY Edition]

Start Page: 1F

Subject Terms: Art markets
Miniaturization
Collectibles
Business growth
Niche marketing
Corporate profiles
Owner operator

Classification Codes: 8630: *Lumber & wood products industries*

9110: *Company specific*

2130: *Executives*

9190: *United States*

Geographic Names: Portland Maine

Dateline: BREWER

Personal Names: Manship, Sandy

Manship, Tom

Companies: Fernwood of Maine **Sic:321999**

Abstract:

Growth has put Fernwood of Maine in competition with other companies that make similar custom miniatures. These include national firms, such as The Cat's Meow Village in Ohio. To be successful, Fernwood of Maine has had to distinguish its product.

Sitting in Fernwood of Maine's workshop recently, [Tom Manship] set two pieces on a table. They were replicas of St. Mary's Church in Bangor. One was made by Fernwood of Maine. The other was by Cat's Meow.

PHOTO: 3 color; Caption: Staff photos by David MacDonald Sandy Manship, who owns Fernwood of Maine with husband, Tom, paints final details of an elementary school for a Massachusetts client. Prints will be made from the painting, laminated onto wood and hand- finished. Printed images of St. John's Catholic Church in Bangor are laminated to fiberboard, then cut into individual pieces. Designs on display at Fernwood's Brewer workshop are among more than 300 the company has produced.

Full Text:

Copyright Portland Newspapers Jun 11, 2000

What Sandy and Tom Manship remember most about the Chateau Frontenac, the towering landmark hotel in Quebec City, is trying to agree on its color.

It was an important detail. The hotel's management had made a rush order for 250 painted replicas of the building for a Thanksgiving event. Over the phone in broken English, the management asked for a last-minute color change, plus tiny lights painted around the doorways on the ground floor. With time tight, Sandy and Tom wound up jumping in the car and hand-delivering the job to Canada.

"We haven't missed a deadline yet," Tom said. "We're pretty proud of that."

Trying to see what's inside a customer's mind is an ongoing challenge when you're in the business of creating miniature wooden replicas of buildings and other landmarks. But Sandy and Tom Manship are finding a niche in this unusual, competitive line of work. Their 5-year-old company, Fernwood of Maine, has been doubling its output annually and is expanding to take on projects along the East Coast.

Behind the growth is a desire for people to own custom-made, colorful reproductions of buildings and scenes that are meaningful in their lives.

Miniature painted replicas are becoming fixtures in gift shops and other sales outlets. Two dimensional images mounted on wood, they come in many different varieties and styles. Each attempts to capture some essential details that convey the character of the subject, and perhaps trigger a memory or feeling.

These reproductions appeal to collectors, of course. But they also seem to be attracting a wider audience, nostalgic about the passing of familiar local places. This broader interest has helped Fernwood of Maine evolve from a home hobby to a growing enterprise expected to gross \$250,000 this year. From a small workshop in a two-story garage on Route 1A, the operation churns out up to 500 separate pieces a week.

The company currently makes roughly 300 different replicas. They include a series of lighthouses from Maine to Florida, churches, schools, libraries, inns and historic buildings. Best sellers of Maine replicas include Portland Head and West Quoddy lighthouses, the Lucerne Inn and the former Sterns High School in Millinocket.

As with many small businesses, growth came from hard work and a lucky break.

Six years ago, Sandy Manship was a nurse and self-taught painter. Looking for some extra cash for family activities, she started working with a Bangor bank to hand paint replicas of newly purchased homes, which were then given to the buyers.

One day, a summer resident who did business with the bank asked Sandy to paint four replicas as a gift. The woman wanted copies of buildings in the Down East town of Brooksville. These were places made famous in "One Morning in Maine," Robert McCloskey's classic children's book. So Sandy painted miniatures of the Brooksville Church, Bucks Harbor Marina, Condon's Store and Condon's Garage.

From that job, the Manships saw a market.

Today, Tom, who is 41, has left his job as a clothing store manager to run the business. Sandy, who is 40, paints three or four new models a week. The company employs up to nine people at busy times, including a sales representative and contract artists.

Growth has put Fernwood of Maine in competition with other companies that make similar custom miniatures. These include national firms, such as The Cat's Meow Village in Ohio. To be successful, Fernwood of Maine has had to distinguish its product.

Sitting in Fernwood of Maine's workshop recently, Tom set two pieces on a table. They were replicas of St. Mary's Church in Bangor. One was made by Fernwood of Maine. The other was by Cat's Meow.

The Fernwood version was multicolored and deeply shaded, with strong details in the stained-glass window. The Cat's Meow piece was printed with a silk-screen process using four colors. The stained-glass window was blue. The Fernwood version looked handcrafted, while the one from Cat's Meow appeared mass produced. Both retail for around \$20.

The church replica suggested two reasons for Fernwood of Maine's success.

One is nostalgia. As people age, they want a keepsake to remember important buildings and places.

For example: Generations of Millinocket-area residents graduated from Sterns High School. But the school is closed now, turned into apartments. And many of the people who grew up in Millinocket and attended the high school have moved away.

At Creative Paper & Gifts in Millinocket, the replica of Sterns High School is a top seller. Its success has led the store to ask Fernwood of Maine to make other replicas of former landmarks that represent better times in the papermaking town: The Millinocket Theater, the Great Northern Hotel and Chauncy's hot dog cart.

Sue Pray, who works at the gift shop, said these pieces typically are requested by people 45 and older. It's a matter of hometown pride, she said, and they sell briskly at \$18.99 each.

"We haven't gone wrong with anything yet," Pray said.

In Portland, Kathy Vinson is selling a series of the city's three high schools. The owner of Romard's Hallmark, Vinson carries replicas of the Longfellow House and Portland Observatory. Fernwood's sales representative suggested copies of Portland, Deering and Cheverus high schools in time for graduation season. They have been selling well in recent weeks, Vinson said, and she is considering orders for other local landmarks, possibly City Hall, the First Parish Church or Victoria Mansion.

Vinson said she has seen a replica of the Cat's Meow rendition of Portland High School for sale in another gift shop.

"It doesn't come close," she said of the craftsmanship. "And we like the idea that these are from Maine."

A second reason for growth is a demand by service organizations and clubs for pieces that are used for fund raising or awards.

Late last month, the Manships were busy meeting a deadline for the East Boston Rotary Club. The club had ordered three pieces: East Boston High School, Piers Park and the tall ship Flying Cloud.

In the paint shop, 60 copies of each piece were lined up on tables. Three workers, one of them the Manships' teen-age daughter, were brushing paint on the wooden edges to finish the job. When the paint dried, the pieces would be ready to ship.

Fernwood of Maine will custom make any landmark. A client must buy at least 60 copies.

Each piece generally starts with photographs. Clients are asked to photograph the overall building, then zoom in on significant details, such as doors and windows. Sometimes the Manships must rely on historical photos or paintings.

Sandy or a contract artist then uses acrylic paint to create the image on paper. The painting goes to a specialty print shop, which reproduces the image as a print.

In the workshop, Tom cuts out copies of the print and laminates them onto sturdy pieces of composite

board. Each board is cut on a bandsaw to reflect the shape of the print, then sanded. After the bottoms and edges are painted, a clear finish is brushed on to give the piece a hand-painted look.

The Manships used to spend a lot of time calling gift shops and trying to persuade them to order pieces. Now gift shops are calling them. Late last month, Sandy was painting a version of the U.S. Coast Guard training ship Eagle, which will be in Portland Harbor next month for OpSail 2000. Southern Maine gift shops could sell hundreds.

By year's end, Fernwood of Maine expects to have a Web site and a couple of new employees. Tom said he believes the company could double or triple its orders this year, but both he and Sandy hope to grow the business at a controlled pace. They want to make sure that quality stays high and that they can develop a pool of artists who can reproduce the pieces in a consistent style.

The Manships also say they are seeking a balance between work and family. The time may come, they said, when they want to sell the company. So they want Fernwood of Maine to grow to a level where it doesn't depend on Sandy painting four new pieces a week and Tom cutting 60 shapes on his bandsaw.

"But for now," he said, "we like coming in every day and doing the work ahead of us."

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[Illustration]

PHOTO: 3 color; Caption: Staff photos by David MacDonald Sandy Manship, who owns Fernwood of Maine with husband, Tom, paints final details of an elementary school for a Massachusetts client. Prints will be made from the painting, laminated onto wood and hand-finished. Printed images of St. John's Catholic Church in Bangor are laminated to fiberboard, then cut into individual pieces. Designs on display at Fernwood's Brewer workshop are among more than 300 the company has produced.

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Hot Wheels® cars roared into the toy world in 1968. More than years later, the brand is hotter than ever—and now encompasses end collectibles, NASCAR® and Formula One models for adults well as high-performance cars, track sets, and playsets for kids of

Hot Wheels® Car

**THE HEART OF THE BRAND**

Kids will always be the heart of the brand. Today, over 15 million boys ages 5-15 are avid collectors, and the average boy collector owns more than 41 Hot Wheels cars. In fact, somewhere in the world two Hot Wheels cars are sold every second of the day! The Hot Wheels brand continues to lead the industry with fresh, innovative products relevant to the market. Some of the current offerings include Monster Trucks, Mechanix, and Sho-gun Racers. Hot Wheels vehicles have even extended into other X-treme wheeled sports lines, including skateboard products and motocross product endorsed by Jeremy McGrath.

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The brand that began with small die-cast vehicles is now involved with almost every racing circuit in the world from NASCAR® to Formula One. Cars, drivers, tracks, and signs emblazoned with the familiar red and yellow flame logo have appeared in NASCAR® (National Association for Stock Car Auto Racing), Formula One, NHRA (National Hot Rod Association), CART (Championship Auto Racing Teams), AMA (American Motorcycle Association), and many other circuits.


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1940s	1950s	1960s	1970s	1980s	1990s	2000s	2010s	2020s
1965 Mattel enters the educational preschool market with See 'N Say® talking toy. 	1968 Mattel rolls out Hot Wheels® die-cast vehicles. 	1968 Mattel embarks on its "World of the Young" acquisition strategy. 	1968 Mattel introduces Christie®, an African-American doll. 					

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